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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,513	01/07/2005	Mario Polegato Moretti	264325US6PCT	5466
22850 7590 07/02/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER KAVANAUGH, JOHN T				
ART UNIT 3728		PAPER NUMBER		
NOTIFICATION DATE 07/02/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/520,513

Applicant(s)

MORETTI ET AL

Examiner

/Ted Kavanaugh/

Art Unit

3728

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10, 12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-10, 12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 19, 2008 has been entered.

Specification

2. The amendment filed Nov. 19, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The change deleting "thermoplastic polyurethane" from the specification. Originally it was just "thermoplastic polyurethane adhesive" manufactured by the company SCHAETTI, and now it implies all the adhesives manufacture by the company SCHAETTI. According to applicant "thermoplastic adhesive" was incorrectly translated into the PCT. However, applicant has not provided any proof of this.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-10,12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5983524 (Polegato) in view of the prior art admitted on page 5, line 16 to page 6, line 2.

Polegato teaches a waterproof and breathable sole (see figure 12) including a tread member (702 and a midsole component comprising a lower protective layer (716), a membrane (715) and a preassemble insert that comprises a perimetric element (704) wherein the membrane and the protective layer are joined by spot gluing; see col. 3, lines 11-15. Polegato lacks the spot gluing being a thermoreactive adhesive. Applicant teaches in the specification (see page 5, line 16, to page 6, line 2) that a thermoreactive adhesive is known. Such an adhesive is used to provide a stronger bond between layers; see page 5, lines 24-26. Therefore, it would have been obvious for the adhesive (glue) of Polegato to be a thermoreactive adhesive to provide a stronger bond between the layers. Figure 12 was sighted above but all of the other embodiments also have a tread and a midsole component has a membrane and lower protective layer. The method of making and the method of joining in claims 14 and 12, respectively, do not add any further limitations to the claims. The method steps follow the obvious method of assembling the waterproof and breathable sole for footwear as taught above.

Response to Arguments

5. Applicant's arguments filed 6/19/2007 have been fully considered but they are not persuasive.

With respect to the objection to the specification for introduction of new matter, applicant argues that an incorrect translation of the PCT application is the problem. The Italian application (PD2002A000187) which claims priority of the PCT application has the section in question as translated as follows "Thermoreactive adhesives are, for example, manufactured by the company Schaetti AG-Switzerland and marketed under the name PU SCHAEETTI 6050" and the wording "thermoplastic polyurethane adhesives which are" has been erroneously introduced.

In response, if this is the true translation then why does the amendment to the specification filed Nov. 19, 2007 state something different and includes the language "adhesives which are"? Originally in the US application, it was just "thermoplastic polyurethane adhesive" manufactured by the company SCHAEETTI, and now it implies all the adhesives manufacture by the company SCHAEETTI.

Applicant stated that an affidavit by an Italian translator confirming the translation discussed can be provided if requested.

In response, if applicant still wishes to argue this then perhaps such an Affidavit would be appropriate. However, what applicant alleges this translates to and what was amended in the specification on Nov. 19, 2007 are two different things.

Applicant argues the office action fails to cite to any specific teachings within either reference to support the applied combination.

To the contrary, see page 5, lines 24-26 in the instant specification wherein it teaches the thermoreactive adhesive provides a stronger bond between layers.

Applicant argues that the "thermoreactive adhesive" is from the medical field and thus the shoes as taught by Polegato are from a different field far from each other.

In response, the admitted prior art from the specification is being be used as it teaching of providing a better adhesive to obtain a stronger bond. Merely substituting one adhesive for a better adhesive would provide a benefit to the shoe of Polegato. Therefore, the combination would provide a predictable result.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

6. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. **Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:**

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

/Ted Kavanaugh/
Primary Examiner
Art Unit 3728

TK
July 1, 2008